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| APPLICATION NO.           | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO.     |
|---------------------------|-------------|----------------------|---------------------|----------------------|
| 10/761,099                | 01/21/2004  | Hideo Miyake         | Q79454              | 2438                 |
| 65565                     | 7590        | 12/07/2007           | EXAMINER            |                      |
| SUGHRUE-265550            |             |                      |                     | SCHILLING, RICHARD L |
| 2100 PENNSYLVANIA AVE. NW |             | ART UNIT             |                     | PAPER NUMBER         |
| WASHINGTON, DC 20037-3213 |             | 1795                 |                     |                      |
| MAIL DATE                 |             | DELIVERY MODE        |                     |                      |
| 12/07/2007                |             | PAPER                |                     |                      |

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

|                              |                        |                     |  |
|------------------------------|------------------------|---------------------|--|
| <b>Office Action Summary</b> | <b>Application No.</b> | <b>Applicant(s)</b> |  |
|                              | 10/761,099             | MIYAKE ET AL.       |  |
|                              | <b>Examiner</b>        | <b>Art Unit</b>     |  |
|                              | Richard L. Schilling   | 1795                |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### **Status**

1) Responsive to communication(s) filed on 26 November 2007.

2a) This action is **FINAL**.                    2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### **Disposition of Claims**

4) Claim(s) 1-81,85-87,92-97 and 99-128 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) 1-48,76-81,92-97 and 99 is/are allowed.

6) Claim(s) 49-75,85-87,100-128 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### **Application Papers**

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### **Priority under 35 U.S.C. § 119**

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All    b) Some \* c) None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### **Attachment(s)**

1) Notice of References Cited (PTO-892)

2) Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) Information Disclosure Statement(s) (PTO/SB/08)  
 Paper No(s)/Mail Date \_\_\_\_\_

4) Interview Summary (PTO-413)  
 Paper No(s)/Mail Date. \_\_\_\_\_

5) Notice of Informal Patent Application

6) Other: \_\_\_\_\_

I. Claims 49-75, 85-87 and 100-128 are rejected under 35 U.S.C. 251 as being based upon new matter added to the patent for which reissue is sought for the same reasons as set forth in paragraph 1 of the final rejection filed 10-27-06. In regard to claim 128, the specification does support cyanine IR absorbing dyes in both layers A and B. However, claim 128 still contains the same new matter as its parent claim 110. Applicants' argument that the presence of monomers a-1 to a-3 is preferred is unconvincing since the presence of the comonomers is the only disclosed embodiment in the specification as explained in the final rejection. No generic disclosure of polymers without a-1 to a-3 for layer A is found anywhere in the specification. Replacing structures or compositions of monomers with functional properties for the monomers is new matter. The properties set forth in the instant claims for layer A monomers are the disclosed properties of one of monomers a-1 to a-3 in the specification and are not disclosed as properties for monomers outside the scope of a-1 to a-3. Applicants' argument that "many monomers having the claimed property are disclosed in the specification" is unconvincing since the specification only discloses monomers of a-1 to a-3 as having the claimed property.

Applicants' argument that the disclosure that it is necessary that layer B contain the light absorber is only a preferred embodiment is unconvincing since, as explained in the final rejection, no generic disclosure of layer B not having the light absorber is found anywhere in the specification and layer B not having the light absorber to generate heat is inconsistent with the concept of the invention of using layer A to reduce the amount of heat generated in layer B from the light absorbers from

dispersing into the substrate.

2. Claims 49-75, 85-87 and 100-128 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter as identified in paragraph 1 above which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

3. Claims 49, 50, 53-55, 85-87, 100, 101, 111, 112, 115, 116, 119, 120, 123, 124 and 127 are rejected under 35 U.S.C. 102(b) as being anticipated by Van Damme et al. '502 for the same reasons as set forth in paragraph 3 of the final rejection.

4. Claims 51, 52, 56-75, 102-105, 110, 113, 117, 118, 121, 122, 125, 126 and 128 are rejected under 35 U.S.C. 103(a) as being unpatentable over Van Damme et al. '502 in view of Kawamura et al. '123 and Parsons et al. for the same reasons as set forth in paragraph 4 of the final rejection.

5. Claims 49, 50, 54, 58-61 and 64-67 are rejected under 35 U.S.C. 102(b) as being anticipated by West et al. '222 for the same reasons as set forth in paragraph 5 of the final rejection.

7. Applicant's arguments filed 11-26-07 have been fully considered but they are not persuasive. The new matter arguments are answered above. Applicants' argument that West et al. and Van Damme et al. do not disclose underlayers with polymers with over 10% monomers that increase plate wear and sensitivity is unconvincing. West et al. and Van Damme et al. disclose underlayer polymers with monomers and the under

layers would, at least to some extent, reduce heat generated in overlayers from dispersing into substrates as explained in paragraph 6 of the final rejection. The underlayer A of the instant claims reduces heat dispersion into substrates thereby allowing more heat for more effective development of layer B and improving sensitivity and development latitude ( see col. 4, lines 19-32 ). Therefor, underlayers that reduce heat dispersion into substrates at least to some extent would provide more heat for development and increase plate wear and sensitivity. The underlayers of the instant claims are not limited to copolymers with monomers a-1 to a-3 to materially distinguish over the underlayers of Van Damme et al. or West et al. The processes disclosed in Van Damme et al. are immaterial to the instant claims which are not drawn to processes. Applicants' argument that Van Damme et al. do not set forth phenolic polymer thermosensitive overlayers is unconvincing. The thermosensitive layers in Van Damme et al. ( col.3, lines 1-3; col. 4, lines 1-12; col. 5, lines 37-50 ) contain binders the same as the interlayers or the photosensitive layers. One out of 8 interlayer binders are phenolic and the photosensitive layer binder is preferably phenolic so that Van Damme et al. puts one skilled in the possession of using phenolic binders in their thermosensitive layers. Applicants' argument that West et al. disclose single layer elements is unconvincing since example 1 in West et al. sets forth hydrophilic acrylamide copolymer subbing layers and col. 6, line 58 – col. 7, line 15 sets forth subbing layers.

8. Walls et al. is cited of interest as disclosing hydrophilic subbing layers of the type used in West et al.

9. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 11-26-07 has been entered.

All claims are drawn to the same invention claimed in the application prior to the entry of the submission under 37 CFR 1.114 and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the application prior to entry under 37 CFR 1.114. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action after the filing of a request for continued examination and the submission under 37 CFR 1.114. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

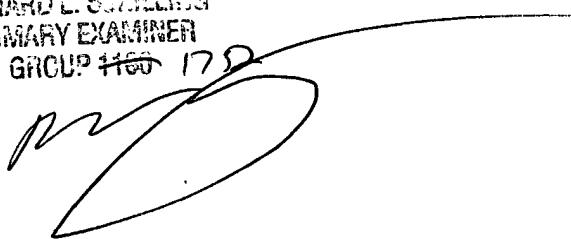
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

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Art Unit: 1795

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Any inquiry concerning this communication should be directed to Richard L. Schilling at telephone number 571-272-1335.

RICHARD L. SCHILLING  
PRIMARY EXAMINER  
GROUP 1100 1795

A handwritten signature in black ink, appearing to read "RICHARD L. SCHILLING", is written over the typed name. To the right of the typed name, there is a handwritten "1795".